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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,228	12/08/2003	Ronald P. Akialis JR.	57391/18 (50-03-060)	2495

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INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

JOHNSON, GREGORY L

ART UNIT	PAPER NUMBER
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3691

NOTIFICATION DATE	DELIVERY MODE
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12/13/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

Office Action Summary

Application No.

10/730,228

Applicant(s)

AKIALIS ET AL.

Examiner

GREGORY JOHNSON

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendment filed October 5, 2007.

Status of Claims

2. Claims 1-25 are pending. Claims 1, 13-16, 18-20 and 24 have been amended. Claims 2-12, 17, 21-23 and 25 are as previously presented. Claims 1-25 have been examined.

Specification

3. Applicants' arguments, see page 11, 3rd para., with respect to informalities within the disclosure have been fully considered and are persuasive. The objection to the specification in the previous Office Action has been withdrawn.

Claim Objections

4. Applicants' amendments and arguments, see page 11, 4th para., with respect to informalities within claims 13-15, 19 and 24 have been fully considered and are persuasive. The objection of claims 13-15, 19 and 24 in the previous Office Action has been withdrawn.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-4, 7-8, 10, 12-15, 20-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne et al., Pub. No. 2003/0229590 (hereinafter Byrne), in view of Stewart et al., Pub No. 2002/0120846 (hereinafter Stewart).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

As to independent claims 1, 13-15 and 20, Applicants amended the claims to include the following limitations:

- A. (a) receiving at an authorization website information entered by a consumer and sent by a biller through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment;
- B. (b) editing the information sent by the biller and returning edit failure information to the consumer and the biller if editing fails;
- C. (c) if editing does not fail, determining whether the payment should be authorized; and
- D. (c) said programmed digital computer system being programmed to edit information relating to payment requests received at said billers' web servers from payers' computers through the worldwide web.

Byrne discloses limitation A:

- (a) receiving at an authorization website information entered by a consumer and sent by a biller (e.g. merchant, seller) through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment (para. 0010, 0028 and 0119; and FIG. 2, 4 and 6).

Byrne also discloses the invention substantially as claimed as set forth in the previous Office Action.

However, Byrne does not disclose limitation B, C or D.

Stewart teaches that an electronic payment and authentication system data element values received from a merchant are compared to acceptable edit masks and allowable values in order to ensure that only acceptable data passes to the application server for processing. Data elements that do not pass each verification step are returned to the merchant or the consumer for correction along with an identifying error condition (i.e. editing the information sent by the biller; para. 0076-0077). Stewart also teaches that the authorization computer within the system generates response messages indicative of one of a first condition and a second condition, where the first condition is an acceptance and the second condition is a declination (i.e. determining whether the payment should be authorized; para. 0009-0011). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Stewart within Byrne for the motivation of verifying the authenticity of a payer, validate debit data, and facilitate debit payment transactions (Abstract).

As to claims 2-4, 7-8, 10, 12, 21-22 and 24, the rejections stand as set forth in the previous Office Action.

8. Claims 5-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Stewart as applied to claim 1 above, and further in view of Ensel et al., Pat. No. 6,493,685 (hereinafter Ensel) as set forth in previous Office Action.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Stewart as applied to claim 1 above, and further in view of Mersky et al., Pat. No. 6,119,106 (hereinafter Mersky) as set forth in previous Office Action.

10. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Stewart and Lewis et al., Pub. No. 2002/0029194 (hereinafter Lewis).

As to independent claim 16, Applicants amended the claim to include the following new limitations:

- A. (a) receiving at an authorization website information entered by a consumer and sent by a biller through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment;
- B. (b) editing the information sent by the biller and returning edit failure information to the consumer and the biller if editing fails; and
- C. (c) if editing does not fail, determining whether the payment should be authorized.

Byrne discloses limitation A:

- (a) receiving at an authorization website information entered by a consumer and sent by a biller (e.g. merchant, seller) through the worldwide web identifying the payor, and specifying the amount to be paid

and the account to be used in making the payment (para. 0010, 0028 and 0119; and FIG. 2, 4 and 6).

Byrne and Lewis disclose and teach the invention substantially as claimed as set forth in the previous Office Action.

However, neither Byrne nor Lewis disclose or teach limitation B or C.

Stewart teaches that an electronic payment and authentication system data element values received from a merchant are compared to acceptable edit masks and allowable values in order to ensure that only acceptable data passes to the application server for processing. Data elements that do not pass each verification step are returned to the merchant or the consumer for correction along with an identifying error condition (i.e. editing the information sent by the biller; para. 0076-0077). Stewart also teaches that the authorization computer within the system generates response messages indicative of one of a first condition and a second condition, where the first condition is an acceptance and the second condition is a declination (i.e. determining whether the payment should be authorized; para. 0009-0011). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Stewart within Byrne for the motivation of verifying the authenticity of a payer, validate debit data, and facilitate debit payment transactions (Abstract).

As to dependent claim 17, the rejection stands as set forth in the previous Office Action.

11. As to independent claims 18-19, Applicants amended the claims to include the following new limitations:

- A. (a) receiving at an authorization website information entered by a consumer and sent by a biller through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment;
- B. (b) editing the information sent by the biller and returning edit failure information to the consumer and the biller if editing fails; and
- C. (c) if editing does not fail, determining whether the payment should be authorized.

Byrne discloses limitation A:

- (a) receiving at an authorization website information entered by a consumer and sent by a biller (e.g. merchant, seller) through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment (para. 0010, 0028 and 0119; and FIG. 2, 4 and 6).

Byrne also discloses the invention substantially as claimed as set forth in the previous Office Action.

However, Byrne does not disclose limitation B or C.

Stewart teaches that an electronic payment and authentication system data element values received from a merchant are compared to acceptable edit masks and allowable values in order to ensure that only acceptable data passes to the application

server for processing. Data elements that do not pass each verification step are returned to the merchant or the consumer for correction along with an identifying error condition (i.e. editing the information sent by the biller; para. 0076-0077). Stewart also teaches that the authorization computer within the system generates response messages indicative of one of a first condition and a second condition, where the first condition is an acceptance and the second condition is a declination (i.e. determining whether the payment should be authorized; para. 0009-0011). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Stewart within Byrne for the motivation of verifying the authenticity of a payer, validate debit data, and facilitate debit payment transactions (Abstract).

12. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Stewart as applied to claim 20 above, and further in view of Mersky as set forth in previous Office Action.

Response to Arguments

13. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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GREGORY JOHNSON
Examiner
Art Unit 3691



LALITA M. HAMILTON
PRIMARY EXAMINER